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Dkt. 69222-A/JPW/GAG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Tamara Byk and Ayelet Chajut	
Serial No.	:	10/817,525	Examiner: Q. Janice Li
Filed	:	April 1, 2004	Art Unit: 1633
For	:	sFRP1 AND USES THEREOF	

1185 Avenue of the Americas
New York, New York 10036
December 28, 2006

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO SEPTEMBER 29, 2006 OFFICE ACTION AND PETITION FOR A TWO-MONTH EXTENSION OF TIME

This Communication is submitted in response to the September 29, 2006 Office Action issued by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the September 29, 2006 Office Action was initially due October 29, 2006. Applicants hereby petition for a two-month extension of time for responding to the September 29, 2006 Office Action. The fee for a two-month extension of time for a small entity is TWO HUNDRED AND TWENTY FIVE DOLLARS ($225.00) for a small entity and a check for this amount is enclosed. With a two-month extension of time, a response to the September 29, 2006 Office Action is now due December 29, 2006. Accordingly, this Communication is being timely filed.

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Restriction Requirement Under 35 U.S.C. §121

In the September 29, 2006 Office Action, the Examiner required restriction under 35 U.S.C. §121 of pending claims 1-26 to an invention defined by one of the following ten groups of claims:

I. Claims 1-3, drawn to a process for inducing proliferation of stem cells comprising administering to cultured stem cells a sFRP1 polypeptide;

II. Claims 1-3, drawn to a process for inducing proliferation of stem cells comprising administering to cultured stem cells an expression vector comprising sFRP1 gene;

III. Claims 4-7, drawn to a process for inducing proliferation of stem cells comprising culturing the stem cells with a second type of cells expressing a sFRP1 polypeptide;

IV. Claims 8-14, drawn to a method for treating a patient suffering from depletion of a cellular population comprising administering stem cells to the patient;

V. Claims 15-20, drawn to a method for treating a patient suffering from depletion of a cellular population comprising administering to the patient sFRP1 polypeptide;

VI. Claims 15-20, drawn to a method for treating a patient suffering from depletion of a cellular population comprising administering to the patient an expression vector comprising the sFRP1 gene;

VII. Claims 21 and 22, drawn to a pharmaceutical composition comprising an expression vector comprising the sFRP1 gene;

VIII. Claims 21 and 22, drawn to a pharmaceutical composition comprising an expression vector comprising the sFRP1 gene;

IX. Claims 23 and 24, drawn to a process for identifying a compound, which induces stem cell proliferation by modulating sFRP1 polypeptide;

X. Claims 25 and 26, drawn to a process for identifying a compound comprising measuring sFRP1 binding activity *in vivo*, and a kit for use in the assay.

On page 5 of the September 29, 2006 Office Action, the Examiner stated that restriction between product and process claims is required. The Examiner indicated that where the applicant elects claims directed to a product and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be rejoined and the applicable restriction requirement withdrawn.

On page 6 of the September 29, 2006 Office Action, the Examiner asserted that the application contains claims directed to a number of patentably distinct species of the claimed invention. The Examiner stated that upon election of an invention for examination a further species election is necessary as follows:

a. Upon election of one of the inventions I-VI, IX or X, further elect the type of stem cells subject for regulation, or used for treatment such as embryonic stem cells or hematopoietic stem cells;

b. Upon election of one of the inventions IV-VI, further elect a specific type of disease for treatment, e.g. and autoimmune disease or cancer; and

c. Upon election of group X, further elect a species with which the sFRP1 interacts in vivo, and a means for measuring said interaction.

On page 7 of the September 29, 2006 Office Action the Examiner stated that under 35 U.S.C 121 applicants are required to elect a single disclosed species from each of a, b and c for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner further stated that currently claims 1-26 are generic, i.e. no single claim is drawn to a particular species.

The Examiner further stated that a reply to this requirement to be complete must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon.

In response to the restriction requirement, applicants hereby elect, with traverse, to prosecute the invention identified by the Examiner as Group I, i.e. claims 1-3, drawn to a process for inducing proliferation of stem cells. In response to the species election requirement, applicants hereby elect, with traverse, hematopoietic cells as the type of stem cells. Applicants note that claims 1 and 2 of Group I read on this elected species.

Applicants, moreover, respectfully request that the Examiner reconsider and withdraw the restriction requirement, particularly insofar as it involves Group IV (claims 8 and 10-14). Applicants respectfully submit that claims 8 and 10-14 all depend directly or indirectly from claim 1; and the method or process of claims 8 and 10-14 necessarily includes all steps of claim 1, and therefore the claims of Group IV are not drawn to an invention which is independent and distinct from that of elected Group I; and there

would not be a serious burden on the Examiner if the restriction were not required, because a search of the prior art relevant to certain claims of Group IV i.e. claims 8 and 10-14, would not impose a serious burden once the prior art relevant to Group I (claims 1-3) has been identified. Therefore, there would be no serious burden on the Examiner to examine Group IV (claims 8 and 10-14) together with Group I (claims 1-3) in the subject application.

In view of the foregoing, applicants maintain that the restriction requirement as between Groups I and IV (at least claims 8 and 10-14) under 35 U.S.C. §121 is not proper, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed $225.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Communication. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450

12/28/06

John P. White
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Date